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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

MAURO JR, THOMAS J

ART UNIT PAPER NUMBER

2143

DATE MAILED: 10/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/867,542		UCHIYAMA ET AL.	
	Examiner		Art Unit	
	Thomas J. Mauro Jr.		2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers


- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>20020606</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-91 are pending and are presented for examination. A formal action on the merits of claims 1-91 follows.

Specification

2. The disclosure is objected to because of the following informalities: Numerous spelling errors occur throughout the application, such as: Abstract contains a spelling error (Abstract – line 11) “changed” which should be “charged” and in claim 77, “sections” should be “selections.” Please correct these and all other spelling errors throughout the specification.

Appropriate correction is required.

Claim Objections

3. Claim 34 is objected to because of the following informalities: Claim 34 depends from claim 35, however, that claim has not yet been recited. For purposes of examination, Examiner interprets this error to mean “... apparatus as recited in claim 33”. Appropriate correction is required.

4. Claim 43 is objected to because of the following informalities: Claim 43 line 17 recites “using said second communication pass” Second communication pass, however, is not associated with the digital display device, first communication pass, however, is associated with

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the digital display device and therefore Examiner interprets this to be an obvious error which should be changed to "first communication pass". Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2, 11-12, 25-26, 49-51 and 76-79 are rejected under 35 U.S.C. 102(e) as being anticipated by Henrick (U.S. 6,507,727).

With respect to claim 1, Henrick teaches a digital information distribution apparatus comprising:

a digital information server which stores digital information to be distributed [Henrick --
Figure 1, Col. 3 lines 11-13 and Col. 5 lines 24-39 – Web server provides music download service, i.e. digital information, via either the digital information stored on the web serve, another server or a third party server];

at least one digital display device for displaying said digital information [Henrick -- **Figure 1, Col. 3 lines 3-10 and lines 42-47 – Digital display device, i.e. user PC, receives the downloaded digital content, i.e. media, for playing**];

a telecommunication device which requests said digital information [Henrick -- **Figures 1 and 5A-C, Col. 3 lines 1-3, Col. 4 lines 13-45 and Col. 5 lines 1-23 – Digital cellular phone, i.e. telecommunication device, requests song to be downloaded to PC**];

a first communication pass for communication with said digital information server and said display device [Henrick -- **Col. 3 lines 3-15 – Digital information server, i.e. web server, and display device, i.e. user PC, are linked via the Internet**];

a second communication pass for communication with said telecommunication device and said digital information server [Henrick -- **Col. 3 lines 3-15 and Col. 4 lines 17-19 – Telecommunication device, i.e. digital cell phone, is linked via wireless technology and the Internet to digital information server, i.e. web server**];

wherein said digital information server provides a plurality of menus for making a plurality of selections to display said digital information on said display device via said first communication pass, said selections being made using said telecommunication device and sent to said digital information server via said second communication pass [Henrick -- **Figures 1 and 5A-C, Col. 4 lines 13-39 and Col. 5 lines 1-10 – Once digital cell phone connects to web server, menus are displayed for selecting a song**], wherein said digital information selected to be displayed is sent to said digital display device from said digital information server via said second communication pass based on said selections [Henrick -- **Figure 1 and Col. 5 lines 11-**

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45 – Digital information media is sent to user PC based upon selections made on digital cell phone of user].

With respect to claim 2, Henrick further teaches wherein said plurality of menus comprises a first and a second menu, and said plurality of selections comprises a first and a second selection [**Henrick -- Figures 5A-C, Col. 4 lines 13-39 and lines 46-53 and Col. 5 lines 1-10 – Multiple menus are provided on phone to select a station and then select whether to download the song or album, i.e. multiple selections].**

With respect to claim 11, Henrick further teaches wherein said selection is made by pushing a keypad of said mobile device [**Henrick -- Figures 5A-5C, Col. 4 lines 13-39 and lines 46-50 and Col. 5 lines 8-10 – User selects options on mobile phone by using the scrolling and selection buttons (503)].**

With respect to claim 12, Henrick further teaches wherein each display device is connected to said digital information server using said first communication pass [**Henrick -- Col. 3 lines 3-15 – Digital information server, i.e. web server, and display device, i.e. user PC, are linked via the Internet], and each display device has identification information [Henrick -- Figure 4 and Col. 5 lines 11-16 – Every computer connected to a network will have unique identification information, namely in the form of an IP/network address. This is what allows the web server to locate the user's PC and download the digital information].**

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With respect to claim 25, Henrick teaches a digital information distribution apparatus comprising:

a digital audiovisual information server which stores digital audiovisual information to be distributed [Henrick -- Figure 1, Col. 3 lines 11-13, Col. 5 lines 24-39 and Col. 6 lines 1-2 – **Web server provides music and video download service, i.e. audiovisual digital information, via either the digital information stored on the web serve, another server or a third party server**];

at least one digital display device for displaying said digital audiovisual information [Henrick -- Figure 1, Col. 3 lines 3-10 and lines 42-47 – **Digital display device, i.e. user PC, receives the downloaded digital content, i.e. media, for playing**];

a telecommunication device which requests said digital audiovisual information [Henrick -- Figures 1 and 5A-C, Col. 3 lines 1-3, Col. 4 lines 13-45 and Col. 5 lines 1-23 – **Digital cellular phone, i.e. telecommunication device, requests song to be downloaded to PC**];

a first communication pass for communication with said digital audiovisual information server and said display device [Henrick -- Col. 3 lines 3-15 – **Digital information server, i.e. web server, and display device, i.e. user PC, are linked via the Internet**];

a second communication pass for communication with said telecommunication device and said digital audiovisual information server [Henrick -- Col. 3 lines 3-15 and Col. 4 lines 17-19 – **Telecommunication device, i.e. digital cell phone, is linked via wireless technology and the Internet to digital information server, i.e. web server**];

wherein said digital audiovisual information server provides a plurality of menus for making a plurality of selections to display said digital audiovisual information on said display device via said first communication pass, said selections being made using said telecommunication device and sent to said digital information server via said second communication pass [**Henrick -- Figures 1 and 5A-C, Col. 4 lines 13-39 and Col. 5 lines 1-10 – Once digital cell phone connects to web server, menus are displayed for selecting a song/video**], wherein said digital audiovisual information selected to be displayed is sent to said digital display device from said digital information server via said second communication pass based on said selections [**Henrick -- Figure 1 and Col. 5 lines 11-45 – Digital information media is sent to user PC based upon selections made on digital cell phone of user**].

With respect to claim 26, this is an apparatus claim similar to the apparatus claimed in claim 2 above. It has similar limitations; therefore, claim 26 is rejected under the same rationale.

With respect to claims 49-51, these are method claims corresponding to the method claimed in claims 1-2 above. They have similar limitations; therefore, claims 49-50 are rejected under the same rationale.

With respect to claims 76-79, these are method claims which recite similar limitations found in claims 1-2 above. Because they are similar, claims 76-79 are rejected using the same rationale.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3-5, 16-21, 52-54 and 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727) in view of Ronen (U.S. 5,745,556).

Regarding claim 3, Henrick teaches the invention substantially as claimed, as aforementioned in claim 2 above, including connecting the PC to the Internet via a wired connection [**Henrick -- Col. 3 lines 5-6**].

Henrick fails to explicitly teach wherein the wired connection is a telephone line.

Ronen, however, discloses a system for providing information services to a user which includes a PC connected to the Internet via a POTS telephone connection [**Ronen -- Col. 1 lines 52-67 and Col. 4 lines 24-30**].

Both Henrick and Ronen are concerned with providing information services to a user PC through ordering via a communication device, i.e. phone.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include having a connection from a PC to the Internet via a POTS

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telephone connection, as taught by Ronen into the invention of Henrick, in order to provide a very common and notoriously well known method of connecting a user PC to a data network.

Regarding claim 4, Henrick-Ronen teach the invention substantially as claimed, as aforementioned in claim 3 above including wherein said first communication pass is the Internet **[Henrick -- Col. 3 lines 3-6].**

Regarding claim 5, Henrick-Ronen teach the invention substantially as claimed, as aforementioned in claim 4 above including wherein said second communication pass comprises a first line between said telecommunication device and a public telephone network, and a second line between said public telephone network and said digital information server **[Henrick -- Col. 3 lines 1-3 and Col. 4 lines 17-19 – Digital cell phones, i.e. WAP enabled, obviously are routed through a provider's telephone network which provides them with both phone and data services].**

Regarding claim 16, Henrick teaches a digital information distribution apparatus comprising:

a digital information server which stores digital information to be distributed **[Henrick -- Figure 1, Col. 3 lines 11-13 and Col. 5 lines 24-39 – Web server provides music download service, i.e. digital information, via either the digital information stored on the web serve, another server or a third party server];**

a digital display device for displaying said digital information [Henrick -- **Figure 1, Col. 3 lines 3-10 and lines 42-47 – Digital display device, i.e. user PC, receives the downloaded digital content, i.e. media, for playing**];

a telecommunication device which requests said digital information [Henrick -- **Figures 1 and 5A-C, Col. 3 lines 1-3, Col. 4 lines 13-45 and Col. 5 lines 1-23 – Digital cellular phone, i.e. telecommunication device, requests song to be downloaded to PC**];

a first communication pass for communication with said digital information server and said display device [Henrick -- **Col. 3 lines 3-15 – Digital information server, i.e. web server, and display device, i.e. user PC, are linked via the Internet**];

a second communication pass for communication with said telecommunication device and said digital information server via a telecommunication company [Henrick -- **Col. 3 lines 3-15 and Col. 4 lines 17-19 – Telecommunication device, i.e. digital cell phone, is linked via wireless technology and the Internet to digital information server, i.e. web server through a telecommunication provider**];

wherein said digital information server provides a plurality of menus for making a plurality of selections to display said digital information on said display device via said first communication pass, said selections being made using said telecommunication device and sent to said digital information server via said second communication pass [Henrick -- **Figures 1 and 5A-C, Col. 4 lines 13-39 and Col. 5 lines 1-10 – Once digital cell phone connects to web server, menus are displayed for selecting a song**], wherein said digital information selected to be displayed is sent to said digital display device from said digital information server via said second communication pass based on said selections [Henrick -- **Figure 1 and Col. 5 lines 11-**

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45 – Digital information media is sent to user PC based upon selections made on digital cell phone of user]; and

wherein a predetermined fee is required for providing said digital information [Henrick - Col. 3 lines 60-63, Col. 5 lines 8-10 and lines 43-46 – Payments, i.e. fees, are collected for purchasing information].

Henrick fails to explicitly teach wherein a predetermined fee is charged to an owner of said telecommunication device.

Ronen, however, teaches a system for providing information services to a user which includes a predetermined fee that is charged to an owner of said communication device **[Ronen -- Col. 5 lines 1-23 – Rates or fees, which are predetermined on a per call basis, are charged to their telecommunication device, i.e. phone, and appear on the bill].**

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the use of a third party charge phone number, as taught by Ronen in order to provide a fast and easy payment mechanism in which establishment of a financial relationship or credit card is unnecessary, thereby making the mechanism safer **[Ronen -- Col. 1 lines 44-49].**

Regarding claim 17, Henrick-Ronen teach the invention substantially as claimed, as aforementioned in claim 16 above, including:

a billing server that stores in a memory said predetermined fee to be charged to a said owner of said telecommunication device that was used for selecting said digital information and wherein said billing server prepares a bill based on said predetermined fee to be paid by said owner of said telecommunication device used for selecting said digital information. **[Ronen --**

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Col. 5 lines 53-57 and Col. 6 lines 36-43 – Billing system, i.e. server, charges predetermined fees to the owner of a telecommunications device that was used to order services. It is obvious that a bill is prepared for the customer device containing charges that need to be paid];

Regarding claim 18, Henrick-Ronen teach the invention substantially as claimed, as aforementioned in claim 17 above, including wherein said predetermined fee is stored in said billing server when said selection is made [**Henrick -- Col. 5 lines 43-46 – Fee, i.e. payment, is stored, i.e. charged, to user's account].**

Regarding claim 19, Henrick-Ronen teach the invention substantially as claimed, as aforementioned in claim 18 above, including wherein said billing server calculates said predetermined fee during at least one time period [**Ronen -- Col. 5 lines 16-23 – Fees are incurred based upon call duration, i.e. a fixed fee per minute, i.e. predetermined time period].**

Regarding claim 20, Henrick-Ronen teach the invention substantially as claimed, as aforementioned in claim 19 above, including wherein said billing server stores a call charge made by said telecommunication device [**Ronen -- Col. 5 lines 53-57 and Col. 6 lines 36-43 – Billing system, i.e. server, charges predetermined fees to the owner of a telecommunications device that was used to order services], and calculates said predetermined fee and said call**

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charge during said at least one time period [**Ronen -- Col. 5 lines 4-23 – Fee and call charges are calculated during the duration of the call, i.e. time period**].

Regarding claim 21, this is an apparatus claim similar to the apparatus claimed in claim 5 above. It has similar limitations; therefore, claim 21 is rejected under the same rationale.

Regarding claims 52-54, these are method claims corresponding to the method claimed in claims 3-5 above. They have similar limitations; therefore, claims 52-54 are rejected under the same rationale.

Regarding claims 63-66, these are method claims corresponding to the apparatus claimed in claims 16, 17 and 21 above. They have similar limitations; therefore, claims 63-66 are rejected under the same rationale.

9. Claims 6-10, 22-24, 55-60 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727) and Ronen (U.S. 5,745,556), as applied to claims 5, 16, 54 and 66 above respectively, in view of Sartain et al. (U.S. 5,914,712).

Regarding claim 6, Henrick-Ronen teach the invention substantially as claimed, as aforementioned in claim 5 above, but fail to explicitly teach displaying a phone number on a

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display device and activating said second communication pass when phone number is called with a telecommunication device.

Sartain, however, discloses a group-oriented interactive video system which displays a "1-900" telephone number to order video services, which cause the information to be downloaded to a display device [Sartain -- **Figure 2, Col. 2 lines 49-66, Col. 3 lines 48-57 and Col. 4 lines 6-17**].

Both Henrick-Ronen and Sartain are concerned with order digital information services via a phone.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the displaying of a phone number on a display device which activates a communication path when called for downloading digital information, as taught by Sartain into the invention of Henrick-Ronen, in order to provide a more group-oriented system for displaying interactive media content [Sartain -- **Col. 1 lines 56-58**].

Regarding claim 7, Henrick-Ronen-Sartain teach the invention substantially as claimed, as aforementioned in claim 6 above, including wherein the phone number is a third party charge phone number [Ronen -- **Col. 5 lines 1-40 – 900 telephone number, i.e. charge phone number, is used for billing**].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the use of a third party charge phone number, as taught by Ronen in order to provide a fast and easy payment mechanism in which establishment of a financial relationship or credit card is unnecessary, thereby making the mechanism safer [Ronen -- **Col. 1 lines 44-49**].

Regarding claim 8, Henrick-Ronen-Sartain teach the invention substantially as claimed, as aforementioned in claim 7 above, including wherein a predetermined fee is required for requesting said digital information and said predetermined fee is charged to an owner of said communication device via said third party charge phone number. **[Ronen -- Col. 5 lines 1-23 -- Rates or fees, which are predetermined on a per call basis, are charged to their telecommunication device, i.e. phone, and appear on the bill].**

Regarding claim 9, Henrick-Ronen-Sartain teach the invention substantially as claimed, as aforementioned in claim 8 above, including wherein said telecommunication device is a mobile phone **[Henrick -- Col. 3 lines 1-3 and Col. 4 lines 13-23 -- Telecommunication device is a digital cell phone with web capabilities].**

Regarding claim 10, Henrick-Ronen-Sartain teach the invention substantially as claimed, as aforementioned in claim 9 above, including wherein said digital information server has a voice message which prompts a selection of digital information and that corresponds with a particular menu being displayed on said display device through said second communication pass **[Henrick -- Col. 4 lines 35-38 and lines 50-53 -- System can include a voice response and recognition system to prompt/select broadcast information when user is connected via digital cell phone].**

Regarding claims 22-24, these are apparatus claims similar to the apparatus claimed in claims 6-8 above. They have similar limitations; therefore, claims 22-24 are rejected under the same rationale.

Regarding claims 55-60, these are method claims corresponding to the apparatus claimed in claims 6-11 above. They have similar limitations; therefore, claims 55-60 are rejected under the same rationale.

Regarding claims 67-69, these are method claims corresponding to the apparatus claimed in claims 6-8 above. They have similar limitations; therefore, claims 67-69 are rejected under the same rationale.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727) in view of Rodriguez et al. (U.S. 5,999,207).

Regarding claim 13, Henrick teaches the invention substantially as claimed, however, fails to explicitly teach displaying said identification information. Rodriguez, however, discloses a user interface for a videophone system in which the IP address, i.e. identification information, can be displayed on the screen [**Rodriguez -- Col. 3 lines 66-67 – Col. 4 lines 1-20 and Col. 6 lines 34-38**].

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the displaying of identification information, namely an IP address on a display monitor, as taught by Rodriguez into the invention of Henrick, in order to provide a faster and more convenient mechanism for allowing the user to discern the identification information of his/her computer which may be necessary in registering for services in order to allow the service provider to access/find the proper computer **[Henrick -- Col. 3 lines 60-67 and Col. 5 lines 11-16]**.

Regarding claim 14, Henrick-Rodriguez teach the invention substantially as claimed, as aforementioned in claim 13 above, including wherein said identification number is an identification number that is different for each said display device **[Rodriguez -- Col. 6 lines 34-38 – IP addresses, by design, are unique to each computer connected on a network, i.e. the Internet]**.

11. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727) and Rodriguez et al. (U.S. 5,999,207), as applied to claim 14 above, in view of Kanefsky et al. (US 2002/0026500).

Regarding claim 15, Henrick-Rodriguez teach the invention substantially as claimed, as aforementioned in claim 14 above, including making selections on a telecommunications device **[Henrick -- Figures 1 and 5A-C, Col. 4 lines 13-39 and Col. 5 lines 1-10 – Once digital cell**

phone connects to web server, menus are displayed for selecting a song] to cause digital information server to distribute said digital information to said display device **[Henrick -- Figure 1 and Col. 5 lines 11-45 – Digital information media is sent to user PC based upon selections made on digital cell phone of user]**, but fail to explicitly teach entering an identification number using said telecommunication device.

Kanefsky, however, discloses a method for sharing wireless content between wireless devices which includes manually entering identification information, i.e. an IP or network address, of another device with which information is to be sent **[Kanefsky -- Page 2 paragraph [0016], page 3 paragraphs [0037-0038] and page 4 paragraph [0055]]**.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the entering of identification information via a telecommunication device, as taught by Kanefsky into the invention of Henrick-Rodriguez, in order to provide users with the ability to request information be sent to another device through a simple and convenient GUI input mechanism using a unique ID of a device.

12. Claims 27, 43-48, 70-75 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727) in view of Hunter et al. (U.S. 6,647,417).

Regarding claim 27, Henrick teaches the invention substantially as claimed, as aforementioned in claim 26 above, but fails to explicitly teach wherein said first menu selects a genre and said second menu selects a title.

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Hunter, however, discloses a music distribution system which displays to a user a GUI which enables them to select a music category, i.e. genre, along with the song title [**Hunter -- Figure 10, Col. 3 lines 40-48, Col. 5 lines 65-67 – Col. 6 lines 1-22 and Col. 7 lines 44-67**].

Both Henrick and Hunter are concerned with selecting digital information over a cellular phone connection.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the menus of category, i.e. genre, and title, as taught by Hunter into the invention of Henrick, in order to provide the user with a user-friendly and intuitive graphical user interface for easily finding songs based upon their own preferences.

Regarding claim 43, Henrick teaches a digital information distribution apparatus comprising:

a digital information server which stores digital information to be distributed [**Henrick -- Figure 1, Col. 3 lines 11-13 and Col. 5 lines 24-39 – Web server provides music download service, i.e. digital information, via either the digital information stored on the web serve, another server or a third party server**];

at least one digital display device for displaying said digital information [**Henrick -- Figure 1, Col. 3 lines 3-10 and lines 42-47 – Digital display device, i.e. user PC, receives the downloaded digital content, i.e. media, for playing**];

a telecommunication device which requests said digital information [**Henrick -- Figures 1 and 5A-C, Col. 3 lines 1-3, Col. 4 lines 13-45 and Col. 5 lines 1-23 – Digital cellular phone, i.e. telecommunication device, requests song to be downloaded to PC**];

a first communication pass for communication with said digital information server and said display device [**Henrick -- Col. 3 lines 3-15 – Digital information server, i.e. web server, and display device, i.e. user PC, are linked via the Internet**];

a second communication pass for communication with said telecommunication device and said digital information server [**Henrick -- Col. 3 lines 3-15 and Col. 4 lines 17-19 – Telecommunication device, i.e. digital cell phone, is linked via wireless technology and the Internet to digital information server, i.e. web server**];

wherein said digital information server provides a plurality of menus for making a plurality of selections to display said digital information on said display device via said first communication pass, said selections being made using said telecommunication device and sent to said digital information server via said second communication pass [**Henrick -- Figures 1 and 5A-C, Col. 4 lines 13-39 and Col. 5 lines 1-10 – Once digital cell phone connects to web server, menus are displayed for selecting a song**], wherein said digital information selected to be displayed is sent to said digital display device from said digital information server via said second communication pass based on said selections [**Henrick -- Figure 1 and Col. 5 lines 11-45 – Digital information media is sent to user PC based upon selections made on digital cell phone of user**].

Henrick fails to explicitly teach a second mode of operation which provides second digital information by switching to this mode at a predetermined time.

Hunter, however, discloses a music distribution system which has a second mode of operation to download and display advertising information either at specific times or when certain criteria is met [**Hunter -- Col. 4 lines 54-57, Col. 5 lines 65-67 – Col. 6 lines 1-22, Col. 13 lines 34-67**].

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Both Henrick and Hunter are concerned with distributing digital information over the Internet to users.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the second mode of operation for showing advertisements at specific times or when certain criteria is met, as taught by Hunter into the invention of Henrick, in order to affordably and efficiently advertise information in the music industry knowing that customers rarely purchase without prior knowledge of a group, a recommendation, an advertisement, or a song sample [**Hunter -- Col. 3 lines 24-37**].

Regarding claim 44, Henrick-Hunter teach the invention substantially as claimed, as aforementioned in claim 43 above, including wherein said first digital information is audiovisual information [**Henrick -- Figure 1, Col. 3 lines 11-13, Col. 5 lines 24-39 and Col. 6 lines 1-2 – Web server provides music and video download service, i.e. audiovisual digital information, via either the digital information stored on the web serve, another server or a third party server**] and said second digital information is digital advertising information [**Hunter -- Col. 4 lines 54-57 and Col. 13 lines 34-67 – Digital advertising information is distributed to users**].

Regarding claim 45, Henrick-Hunter teach the invention substantially as claimed, as aforementioned in claim 44 above, including wherein said digital information server provides a menu and audiovisual information when said first mode is operated [**Henrick -- Figures 5A-C, Col. 4 lines 13-39 and lines 46-53 and Col. 5 lines 1-10 – Multiple menus are provided on**

phone to select a station and then select whether to download the song or album, i.e. multiple selections], and said digital information server provides said menu and said advertisement information when said second mode is operated [Hunter -- Figure 10, Col. 3 lines 40-48, Col. 5 lines 65-67 – Col. 6 lines 1-22 and Col. 7 lines 44-67 – GUI provides for music selection menus along with advertising information (See Fig. 10 Celine Dion ad)].

Regarding claim 46, Henrick-Hunter teach the invention substantially as claimed, as aforementioned in claim 45 above, including wherein said menu is for selecting a title of said audiovisual information **[Hunter -- Figure 10, Col. 3 lines 40-48, Col. 5 lines 65-67 – Col. 6 lines 1-22 and Col. 7 lines 44-67 – Menu allows user to select category, artist and title for download].**

Regarding claim 47, Henrick-Hunter teach the invention substantially as claimed, as aforementioned in claim 46 above, including wherein said digital information server switches modes based on said selection of said audiovisual information **[Hunter -- Col. 13 lines 34-47 – Advertisements will be stored and displayed based upon selection of said information, i.e. certain ads will only be displayed when users are in a given category, such as country music fans based upon previous selections for the music].**

Regarding claim 48, Henrick-Hunter teach the invention substantially as claimed, as aforementioned in claim 47 above, but fail to teach explicitly wherein said system switches from first mode to a second mode, i.e. show advertisements, if no selection is made for a time period.

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Henrick-Hunter do, however, teach that based upon certain criteria, i.e. events, ads will be displayed [**Hunter -- Col. 13 lines 34-47**].

It is notoriously well known in the art that the display of advertisements are most effective when displayed during interstitial time or other periods of time when no selections or actions are taking place. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify what criteria triggers advertising information to be displayed in the system of Henrick-Hunter in order to provide more user-friendly and less intrusive form of displaying advertisements rather than displaying such ads when a user may be bothered or not interested in the ads.

Regarding claims 70-75, these are method claims corresponding to the apparatus claimed in claims 6-8 above. They have similar limitations; therefore, claims 67-69 are rejected under the same rationale.

Regarding claim 80, this is a method claim corresponding to the apparatus claimed in claim 27 above. It has similar limitations; therefore, claim 80 is rejected under the same rationale.

13. Claims 28-30 and 81-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727) and Hunter et al. (U.S. 6,647,417), as applied to claims 27 and 80 above respectively, in view of Ronen (U.S. 5,745,556).

Regarding claims 28-30, these are apparatus claims corresponding to the apparatus claimed in claims 3-5 above. They have similar limitations; therefore, claims 28-30 are rejected under the same rationale.

Regarding claims 81-83, these are method claims corresponding to the apparatus claimed in claims 3-5 above. They have similar limitations; therefore, claims 81-83 are rejected under the same rationale.

14. Claims 31-38 and 84-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727), Ronen (U.S. 5,745,556) and Hunter et al. (U.S. 6,647,417), as applied to claims 30 and 83 above respectively, in view of Sartain et al. (U.S. 5,914,712).

Regarding claims 31-38, these are apparatus claims corresponding to the apparatus claimed in claims 6-12 above. They have similar limitations; therefore, claims 31-38 are rejected under the same rationale.

Regarding claims 84-89, these are method claims corresponding to the apparatus claimed in claims 6-11 above. They have similar limitations; therefore, claims 84-89 are rejected under the same rationale.

15. Claims 39-40 and 90-91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727), Ronen (U.S. 5,745,556), Hunter et al. (U.S. 6,647,417) and Sartain et al. (U.S. 5,914,712), as applied to claims 38 and 89 above respectively, in view of Rodriguez et al. (U.S. 5,999,207).

Regarding claims 39-40, these are apparatus claims corresponding to the apparatus claimed in claims 13-14 above. They have similar limitations; therefore, claims 39-40 are rejected under the same rationale.

Regarding claims 90-91, these are method claims corresponding to the apparatus claimed in claims 12, 14 and 15 above. They have similar limitations; therefore, claims 90-91 are rejected under the same rationale.

16. Claims 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727), Ronen (U.S. 5,745,556), Hunter et al. (U.S. 6,647,417), Sartain et al. (U.S. 5,914,712) and Rodriguez et al. (U.S. 5,999,207), as applied to claim 40 above, in view of Kanefsky et al. (US 2002/0026500).

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Regarding claims 41-42, these are apparatus claims corresponding to the apparatus claimed in claims 15 and 8 above respectively. They have similar limitations; therefore, claims 41-42 are rejected under the same rationale.

17. Claims 61-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrick (U.S. 6,507,727), Ronen (U.S. 5,745,556) and Sartain et al. (U.S. 5,914,712), as applied to claim 59 above, in view of Rodriguez et al. (U.S. 5,999,207).

Regarding claims 61-62, these are method claims corresponding to the apparatus claimed in claims 12, 14 and 15 above. They have similar limitations; therefore, claims 61-62 are rejected under the same rationale.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Routtenberg et al. (US 2002/0049717) discloses a digital content distribution system for purchasing and delivery of files over a network to a media player.

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- Kwan (US 2002/0147658) discloses a method for conducting payments over a network by debiting and crediting telecommunication accounts.

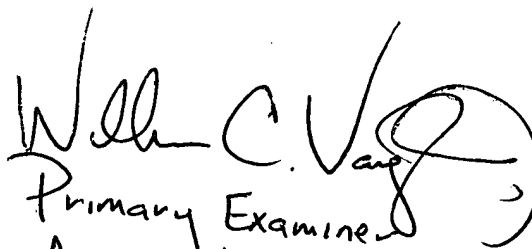
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 571-272-3917. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



TJM
October 27, 2004



Primary Examiner
Art Unit 2143
William C. Vaughn, Jr.